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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/477,855	06/07/95	TAHARA K	450100-2952.

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WILLIAM S FROMMER
CURTIS MORRIS & SAFFORD
530 FIFTH AVE
NEW YORK NY 10036

EXAMINER	
DIN, L	

ART UNIT	PAPER NUMBER
2615	8

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/477,855	Applicant(s) Tahara et al.
	Examiner Luanne Din	Group Art Unit 2615

☒ Responsive to communication(s) filed on *Nov 20, 1996* .

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-23* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-23* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Response to the Terminal Disclaimer

1. The Terminal Disclaimer filed on 11/21/96, paper No. 7, is not proper because the Assignee's signature is missing from the Terminal Disclaimer. Proper submission of the Terminal Disclaimer with the Assignee's signature is required for further consideration.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-3, 5-8, 10-15, 17-20, and 22-23 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4 of prior U.S. Patent No. 5,473,380. This is a double patenting rejection.

For example, claims 1-3 are claiming the same apparatus as U.S. Patent No. 5,473,380 claims 1-4. Although the wording may be different from claim to claim. However, over all, the claimed invention is the same as patented invention. Claims 1-3 specify an apparatus for processing a digital signal including an identification area. U.S. Patent No. 5,473,380 claims 1-4 also specify an apparatus for processing a digital picture signal (claims 1 and 4) and means for receiving picture type signal included in the picture signal (claim 1). The picture type data is considered the identification data of a digital picture signal which is included in the digital picture signal. Furthermore, claims 5-7, 13-15, and 17-19 are claiming the same apparatus and method as U.S. Patent No. 5,473,380 claims 5 and 11-15; claims 8, 10-12, 20, and 22-23 are claiming the same apparatus and method as U.S. Patent No. 5,473,380 claims 6-10 and 16-20.

4. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the

"right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 4,9,16,21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,437,380 in view of Kato (5,543,847).

Claims 1-5 and 11-15 of U.S. Patent No. 5,473,380 discloses substantially the same method and apparatus for processing a digital picture signal comprising a means for receiving picture type signal, coding means for encoding the picture signal including the motion vector detection means, means for separating and encoding according to picture type of the picture signal. Claims 6-10 and 16-20 of U.S. Patent No. 5,473,380 discloses

substantially the same apparatus and method for processing an encoded digital signal comprising means for decoding encoded digital signal includes variable length decoding means and means for including picture type data. Although U.S. Patent No. 5,473,380 does not particularly disclose the picture type data identifies an encoding structure of a group of picture as specified in claims 4, 9, 16, and 21.

Kato discloses substantially the same picture coding and decoding apparatus and method (Fig. 4 and 5, col. 3, line 63 to col. 4, line 39) wherein the picture type data identifies an encoding structure of a group of pictures represented by the digital picture signal and further identifies each respective picture within said group of pictures.

Therefore, it is considered obvious for one of ordinary skill in the art, having the teaching of using the picture type data identifies an encoding structure of a group of pictures represented by the digital picture signal and further identifies each respective picture within said group of pictures as shown by Kato, one can add the signal processing method of Kato to the signal processing of U.S. Patent No. 5,473,380 so that the picture type data can be identified as an encoding structure of a group of pictures represented by the digital picture signal and further identifies each respective picture within said group of pictures.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claims 1-23 are rejected under 35 U.S.C. § 103 as being unpatentable over Kato.

Kato disclose substantially the same apparatus and method for processing a digital picture signal comprising means for receiving picture type signal (Fig. 4, picture counter 22); coding means for encoding the picture signal including the motion vector detection means (Fig. 4, encoder 14) as specified in claims 1, 7, 13 and 19; means for separating and encoding according to picture type of the picture signal (col. 7, lines 17-50) as specified in claims 2-3, 14-15; picture coding and decoding apparatus and method (Fig. 4 and 5, col. 3, line 63 to col. 4, line 39) wherein the picture type data identifies an

encoding structure of a group of pictures represented by the digital picture signal and further identifies each respective picture within said group of pictures as specified in claims 4, 9, 16, and 21; means for decoding encoded digital signal includes variable length decoding means and means for including picture type data (Fig. 8, variable length decoder 31 and GOP header detector 37) as specified in claims 6, 8, 11-12, 18, 20 and 23.

Although Kato does not particularly disclose the picture type data is included in a data identification area of at least a vertical blanking interval of the digital picture signal as specified in claims 5, 10, 17, 22. Examiner wish to take official notice that including the picture type data in a data identification area of at least a vertical blanking interval of the digital picture signal is well known to the art. Therefore, it is considered obvious for one of ordinary skill in the art, having the teaching of the well known method of including the picture type data in a data identification area of at least a vertical blanking interval of the digital picture signal, one can certainly include the picture type data in a data identification area of at least a vertical blanking interval of the digital picture signal so that the digital signal may be processed according to the picture type for display or recording.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luanne Din whose telephone number is (703) 306-2743.

LPD

December 23, 1996

AMELIA AU
PATENT EXAMINER
GROUP 2600
acting spe